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By: *Nancy Foster*



PATENT
Customer Number 22,852
Attorney Docket No. 4121.0165-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Ronda M. Allen et al.) Group Art Unit: 1651
Serial No.: 09/648,641) Examiner: M. MELLER
Filed: August 25, 2000)
For: METHODS FOR PURIFYING)
DNA POLYMERASES)

Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE

Applicants now respond to the Office Action mailed September 10, 2002. The period for reply has been extended three months by the Petition for a Three Month Extension of Time and fee payment filed concurrently herewith.

Applicants thank the Examiner for the courtesies extended to the undersigned during his telephone conversation on December 19, 2002.

The Examiner requires an election under 35 U.S.C. § 121. See Office Action, pages 2-3. However, the Examiner failed to clearly identify each of the disclosed species to which the claims are restricted. When making an election requirement, the Examiner should "[c]learly identify each (or in aggravated cases at least exemplary ones) of the disclosed species to which claims are restricted. ... In the absence of

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distinct figures or examples to identify the several species, the ... other distinguishing characteristic[s] of the species should be stated for each species identified. If the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted." Manual of Patent Examining Procedure ("MPEP") §809.02(a) (B).

The Examiner failed to identify even a single species.

The Examiner also incorrectly places the burden of identifying species on the Applicants. "Applicant is required to enumerate all of the components to be used in the elected invention." Office Action, page 2, third paragraph.

Further, the Examiner failed to explain why an election requirement is required. "Where the related inventions as claimed are shown to be distinct under the criteria of MPEP §806.05(c) - §806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation" that there is (a) a separate classification for each invention, (b) a separate status in the art when [the inventions] are classifiable together, or (c) that the different inventions require a different field of search. MPEP §808.02. The Examiner has failed to provide any appropriate explanation for any of these reasons for requiring an election requirement. Thus, the applicants traverse the election requirement.

Because the Examiner has failed to provide even a single species, the Examiner has made it difficult for the Applicants to make an election without knowing what species the Examiner would find appropriate.

However, the Applicants will attempt to fully respond to the election requirement. The Examiner recites "many different types of chromatography used, the many different

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need prior chromatography column 100

types of enzymes used, cells . . ." Thus, although the Examiner failed to state exactly what species may be elected, the Applicants will interpret the Examiner's requirement as requiring an election of one each of (a) a type of chromatography, (b) a type of enzyme obtained, and (c) a type of cell in a sample (although cells are recited in only three claims, and cells are not recited in any of the other claims). The Examiner also stated that a reply must include a listing of all claims readable on the species elected. Office Action, page 2, fifth paragraph.

which one? see class 5, 16-18

The Examiner may require an election of a species of chromatography used in obtaining a DNA polymerase. Applicants elect Poly U Sepharose chromatography for the method for obtaining DNA polymerase. Applicants note that this election does not preclude any additional chromatography step (e.g., certain embodiments of the claimed invention may use Poly U Sepharose chromatography alone or in combination with other chromatography step or steps). Claims 1-19 are readable thereon.

The Examiner may require an election of a species of enzyme. Applicants elect DNA polymerase as the enzyme. Claims 1-19 are readable thereon.

The Examiner may require an election of a type of cell in a sample from which DNA polymerase is obtained. Applicants elect the species where no cells are present in the sample from which a DNA polymerase is obtained. Claim 1 does not require a cell to be present in a sample.¹ As non-limiting examples, a sample may comprise a cell-free lysate or a sample may comprise cell-free material of unknown origin. Claims 1-12 and 16-19 are readable thereon.

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¹ It also does not preclude a cell from being present.

Furthermore, Applicants traverse the requirement because the Examiner has not established that it would be an undue burden to examine claims 1 and 19, the claims the Examiner stated are generic, and from which all other claims ultimately depend. See MPEP § 803.

Applicants respectfully remind the Examiner that, in the event that the elected species is found allowable, the Examiner is required to examine the claims with respect to the non-elected species. See MPEP §809.02(c)(B)(1).

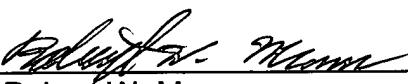
In the event the Examiner has any questions concerning this response, Applicants request that the Examiner contact the undersigned at (650) 849-6676, and respectfully request that the Examiner set forth a proper election requirement and enumerate species suitable for election.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 10, 2003

By: 
Robert W. Mann
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